



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,173	04/11/2001	Jeffrey Jonathan Spurgat	11748/16	1523

7590 01/12/2007
John S. Paniaguas
KATTEN MUCHIN ZAVIS
Suite 1600
525 West Monroe Street
Chicago, IL 60661

EXAMINER

CHOUDHURY, AZIZUL Q

ART UNIT	PAPER NUMBER
----------	--------------

2145

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/833,173

Applicant(s)

SPURGAT ET AL.

Examiner

Azizul Choudhury

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This office action is in response to the correspondence received on October 4, 2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "said peripheral" in lines 13 and 16. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US Pat No: 6,697,944) in view of Birrell et al (US Pat No: 6,332,175), hereafter referred to as Jones and Birrell, respectively.

1. With regards to claim 1, Jones teaches through Birrell a secure architecture for encoded or encrypted digital audio files comprising: a computing platform for receiving and processing encrypted or encoded digital data, said computing platform including a host processor and a peripheral bus, said computing

platform configured to run audio or video playback application software for passing said encrypted or encoded digital data to said peripheral bus, said computing platform configured so that said peripheral bus is not-accessible by said audio or video playback software (Jones' design features a pc (Figure 1 and column 6, line 51 – column 7, line 4, Jones) and provides for trust establishments prior to allowing for the connection between the playback device and the pc from being established (column 4, lines 15-20, Jones) and also provides for unauthorized software not having access to the secure data (audio files, etc) (column 13, lines 26-40, Jones)); a playback device for playing back encrypted or encoded digital data including a separate processor, a peripheral bus interface (Figure 5 and column 9, lines 33-53, Jones), a timing generator and a digital-to-analog converter (DAC) for receiving said encrypted or encoded digital signals from said peripheral bus and decrypting or decoding said encrypting or encoded data signals, said timing generator configured to generate timing signals for said DAC (Timing generators are inherent components of digital designs such as Jones', column 10, lines 8-39 and column 14, lines 18-20, Jones), said peripheral also including a memory device for storing decoding or decryption software (The playback device/peripheral has means for decrypting encrypted data (column 4, lines 8-12 and Figure 5, element 86, Jones)), said peripheral interface coupled to said peripheral bus for receiving said encrypted and encoded digital signals from said peripheral bus (Figure 5, element 68, Jones), said peripheral configured to decrypt or decode said encrypted or encoded digital data and generate a

decoded or decrypted analog output signal for playback by an external analog device (column 4, lines 8-12 and Figure 5, elements 82, 88, 92 and 94, Jones).

While Jones' design teaches the use of digital files for providing music (analog data), Jones does not specifically cite the use of a D/A converter.

In the same field of endeavor, Birrell teaches a portable audio system that connects to a host (column 4, lines 37-49, Birrell). The design features a D/A converter (Figure 1, element 126, Birrell). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Birrell, for the purpose of providing a system and method for storing a large volume of audio data in a portable audio player (column 2, lines 49-52, Birrell).

2. With regards to claim 2, Jones teaches through Birrell the secure architecture, wherein said computing platform includes a network interface for receiving digital data from an external network (column 7, lines 38-40, Jones).

While Jones' design teaches the use of digital files for providing music (analog data), Jones does not specifically cite the use of a D/A converter.

In the same field of endeavor, Birrell teaches a portable audio system that connects to a host (column 4, lines 37-49, Birrell). The design features a D/A converter (Figure 1, element 126, Birrell). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Birrell, for the purpose of providing a system

and method for storing a large volume of audio data in a portable audio player.
(column 2, lines 49-52, Birrell).

3. With regards to claim 3, Jones teaches through Birrell the secure architecture, wherein said peripheral bus is a USB bus (column 9, lines 37-53, Jones).

While Jones' design teaches the use of digital files for providing music (analog data), Jones does not specifically cite the use of a D/A converter.

In the same field of endeavor, Birrell teaches a portable audio system that connects to a host (column 4, lines 37-49, Birrell). The design features a D/A converter (Figure 1, element 126, Birrell). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Birrell, for the purpose of providing a system and method for storing a large volume of audio data in a portable audio player (column 2, lines 49-52, Birrell).

4. With regards to claim 4, Jones teaches through Birrell the secure architecture, wherein said peripheral bus is a PCI bus (column 9, lines 37-53, Jones).

While Jones' design teaches the use of digital files for providing music (analog data), Jones does not specifically cite the use of a D/A converter.

In the same field of endeavor, Birrell teaches a portable audio system that connects to a host (column 4, lines 37-49, Birrell). The design features a D/A converter (Figure 1, element 126, Birrell). Therefore, it would have been obvious

to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Birrell, for the purpose of providing a system and method for storing a large volume of audio data in a portable audio player (column 2, lines 49-52, Birrell).

5. With regards to claim 5, Jones teaches through Birrell the secure architecture, wherein said peripheral bus is a Fire Wire bus (Jones' design allows for the use of buses, it would have been obvious to have used a FireWire bus; column 9, lines 37-53, Jones).

While Jones' design teaches the use of digital files for providing music (analog data), Jones does not specifically cite the use of a D/A converter.

In the same field of endeavor, Birrell teaches a portable audio system that connects to a host (column 4, lines 37-49, Birrell). The design features a D/A converter (Figure 1, element 126, Birrell). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Birrell, for the purpose of providing a system and method for storing a large volume of audio data in a portable audio player (column 2, lines 49-52, Birrell).

6. With regards to claim 6, Jones teaches through Birrell the secure architecture further including one or more user input devices (Figure 1, elements 40 and 42, Jones).

While Jones' design teaches the use of digital files for providing music (analog data), Jones does not specifically cite the use of a D/A converter.

In the same field of endeavor, Birrell teaches a portable audio system that connects to a host (column 4, lines 37-49, Birrell). The design features a D/A converter (Figure 1, element 126, Birrell). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Birrell, for the purpose of providing a system and method for storing a large volume of audio data in a portable audio player (column 2, lines 49-52, Birrell).

7. With regards to claim 7, Jones teaches through Birrell the secure architecture, wherein said computing architecture includes one or more local persistent storage devices (Figure 1, elements 29 and 60, Jones).

While Jones' design teaches the use of digital files for providing music (analog data), Jones does not specifically cite the use of a D/A converter.

In the same field of endeavor, Birrell teaches a portable audio system that connects to a host (column 4, lines 37-49, Birrell). The design features a D/A converter (Figure 1, element 126, Birrell). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Birrell, for the purpose of providing a system and method for storing a large volume of audio data in a portable audio player (column 2, lines 49-52, Birrell).

Response to Remarks

The amendment received on October 4, 2006 has been carefully examined but is not deemed fully persuasive. In lieu of the amendments, the 112-type rejection issued in the previous office action has been withdrawn. However, the amendments have created an insufficient antecedent basis issue. Claim 1 has been amended to change "peripheral" to "playback device." However, the claims continue to refer to "said peripheral" later in the claims creating an insufficient antecedent basis issue. The following are the examiner's response to the two principle points of contention addressed in the present amendment.

The first point of contention involves the claimed computer having a peripheral bus not accessible by any playback applications running on the computing platform. The applicant contends that such a feature is not taught by either prior art, the examiner disagrees. In column 4, lines 15-20, Jones explains how authorized connection have to be established prior to devices being able to communicate with one another. In addition, in column 13, lines 26-40, Jones explains how software (such as unencrypted audio software) within the pc is not able to access the DRM (encrypted software) that is being transferred to the mp3 player.

The second point of contention involves the location of the decryption process. The applicant contends that the claimed invention decrypts the file at the peripheral/playback device. The applicant also contends that Jones' design only allows for decryption of files at the pc and not at the peripheral/playback device. The examiner

Art Unit: 2145

disagrees with this contention. Jones teaches in column 4, lines 8-12 that the mp3 player is able to play encrypted files. This clearly indicates that decrypting means exist within the peripheral/playback device.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

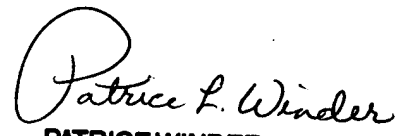
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is (571) 272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2145

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AC


PATRICE WINDER
PRIMARY EXAMINER